



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,537	09/13/2001	Gene M. Shearer	4239-60808	7176
36218	7590	11/04/2003	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 S.W. SALMON STREET, SUITE #1600 ONE WORLD TRADE CENTER PORTLAND, OR 97204-2988			BELYAVSKYI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/936,537	SHEARER ET AL.	
	Examiner	Art Unit	
	Michail A Belyavskyi	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-17, 25, 28 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17, 25, 28 and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1644

RESPONSE TO APPLICANT'S AMENDMENT

1. Applicant's amendment, filed 08/27/03 is acknowledged.

Claims 1-5, 7-17, 25, 28 and 34-37 are pending.

Claims 1-5, 7-17, 25, 28 and 34-37 are under consideration in the instant application.

In view of the amendment, filed 08/27/03 the following rejections remain

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the same reasons set forth in the previous Office Action, mailed 03/25/03.

Applicant's arguments, filed 08/27/03 have been fully considered, but have not been found convincing.

It is apparent that the U251, A1207 and A1235 cell lines are required to practice the claimed invention. As a required elements, they must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If they are not so obtainable or available, the enablement requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit said cell lines. See 37 CFR 1.801-1.809.

Applicant asserts that U251, A1207 and A1235 cell lines are known, as evidenced from numerous publications listed in the PubMed database.

Art Unit: 1644

However, biological materials must be known and readily available to the public (See MPEP 2404.01). Neither concept alone is sufficient. The fact that applicant and other members of the public were able to obtain U251, A1207 and A1235 cell lines from publically available resources prior to and after the filing date of the application does not establish the upon issuance of a patent on the application that such materials would continue to be accessible to the public. The applicant did not make of record any of the facts and circumstances (or sufficient information) surrounding the access to the biological materials from the publically available resources, nor is there any evidence as to the public availability regarding the materials if a patent would be granted. Further, there is no assurance that the public sources would allow unlimited access to the materials if the application has matured into a patent. In the absence of evidence (or sufficient evidence) that U251, A1207 and A1235 cell lines are readily available to the public and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, applicant's arguments are not persuasive and the rejection is maintained.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 3, 4, 13-16, are rejected under 35 U.S.C. 102(a) as being anticipated by Dix A.R et al (FASEF J, 1999, V13, N.4 pp. A 610) for the same reasons set forth in the previous Office Action, mailed 03/25/03.

Applicant's arguments, filed 08/27/03 have been fully considered, but have not been found convincing.

Applicant asserts that because of Declaration under 37 CFR1.132 by Dr. Jian-Ping Zuo and Dr Gene M. Shearer the Dix reference describes the Applicant own work and is not available as a prior art under 35 U.S.C. 102(a).

The declaration filed under 37 CFR1.132 by Dr. Jian-Ping Zuo and Dr. Gene M. Shearer on 08/27/03 is acknowledge. Said declaration states that only Dr. Jian-Ping Zuo and Dr. Gene M. Shearer are the inventors of the instant application and the rest of the authors listed in the Dix A.R et al., reference did not contribute to the conception of the invention. However, it is noted that there are four inventors of the current application and the evidence of the record is not clear why Dr. Jonh E.Coligan and Dr. Claire Chougnet, both co-inventors of the current application are not co-authors of Dix A.R et al., reference.

Art Unit: 1644

The following new ground of rejection is necessitated by the amendment filed 08/27/03

5. The following is a quotation of the second paragraph of 35 U.S.C. 112.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Dependent claims 2 recites "...wherein incubation of monocytes, dendrites and B cells...". There is insufficient antecedent basis for this limitation in base Claim 1, since base Claim 1 does not recite monocytes, dendrites and B cells.

8. No claim allowed

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

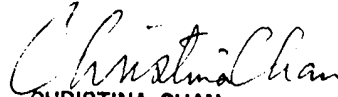
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskiy whose telephone number is (703) 308-4232. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Art Unit: 1644

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Michail Belyavskyi, Ph.D.
Patent Examiner
Technology Center 1600
November 3, 2003


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600